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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/862,825	05/22/2001	Satoru Ueda	7217/64562	8871

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EXAMINER

YIGDALL, MICHAEL J

ART UNIT	PAPER NUMBER
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2122

DATE MAILED: 01/23/2004

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/862,825

Applicant(s)

UEDA, SATORU

Examiner

Michael J. Yigdall

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 November 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. In view of Applicant's response and amendment dated 14 November 2003, claims 1-7 remain pending.

Specification

2. The objection to the disclosure regarding the claim for foreign priority is withdrawn in view of Applicant's remarks.

3. The objection to the length of the abstract is withdrawn in view of Applicant's remarks.

Claim Rejections - 35 USC § 102

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claims 1-3 and 5-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Reeder. This rejection is set forth in the Office action mailed 13 August 2003 (Paper No. 7).

With respect to amended claim 1, Reeder discloses a software program providing system for providing and managing access to a software program (see Fig. 1 and page 3, lines 11-15), comprising:

(a) a storage medium for storing said software program and an individual identification code for identifying said storage medium (see store 150 in Fig. 1, and page 5, lines 1-7, which shows a store or storage medium for storing a software program and an identification code used to identify the program in the storage medium, for example, "the program is read from the store 34...");

(b) a user terminal for installing said storage medium therein and for accessing said software program stored in said storage medium (see apparatus 100 in Fig. 1; see also page 3, lines 32-37, and page 4, lines 1-6, which shows a user apparatus or terminal having a storage medium installed therein for storing and accessing software programs; see also page 5, lines 10-14, which shows obtaining the software program and storing it in the storage medium);

(c) database management means for storing a database including individual information of a user, information regarding a range of access limitations to said software program, and information regarding a condition of access to said software program, wherein said database is searched using said individual identification code as a search key (see code data 230 in Fig. 1; see also page 6, line 37, and page 7, lines 1-5, which shows a data store or database having individual user information regarding software usage rights, i.e. access limitations and conditions of access, which is searched based on an identification code); and

(d) information communication means for connecting said database management means with said user terminal (see communications link 10 and network 20 in Fig. 1; see also page 3, lines 21-31), wherein

said software program providing system authorizes said user terminal to access said software program based on said information regarding said range of access limitations (see page 7, lines 30-37), said information regarding said condition of access to said software program, and said information searched using said individual identification code as a search key (see page 6, line 37, and page 7, lines 1-5), said database management means reading said individual identification code from said storage medium installed in said user terminal through said information communication means (see page 10, lines 6-17, which shows reading a identification

code from a storage medium, and page 11, lines 15-29, which then shows authorizing the use of a software program based on access limitations and conditions).

With respect to amended claim 5, Reeder discloses a software program providing method for providing and managing access to a software program (see Fig. 1 and page 3, lines 11-15), comprising the following steps of:

(a) storing said software program in a storage medium along with an individual identification code for identifying said storage medium (see store 150 in Fig. 1, and page 5, lines 1-7, which shows a store or storage medium for storing a software program and an identification code used to identify the program in the storage medium, for example, "the program is read from the store 34...");

(b) storing into a database, information regarding individual information of a user, information regarding a range of access limitations to said software program, and information regarding a condition of access to said software program, wherein said database is searched using said individual identification code as a search key (see code data 230 in Fig. 1; see page 6, line 37, and page 7, lines 1-5, which shows a data store or database having individual user information regarding software usage rights, i.e. access limitations and conditions of access, which is searched based on an identification code);

(c) communicating between a user terminal having said storage medium installed therein and a database management means managing said database (see communications link 10 and network 20 in Fig. 1; see also page 3, lines 21-31),

wherein said communicating is done when said user accesses said software program stored in said storage medium installed in said user terminal (see page 5, lines 18-25, which shows initiating a transmission when the user accesses the software program); and

(d) authorizing said user terminal to access said software program based on said information regarding said range of access limitations (see page 7, lines 30-37), said information regarding said access condition to said software program, and said information searched from said database based on said individual identification code (see page 6, line 37, and page 7, lines 1-5), wherein said individual identification code is read out from said storage medium installed in said user terminal (see page 10, lines 6-17, which shows reading a identification code from a storage medium, and page 11, lines 15-29, which then shows authorizing the use of a software program based on access limitations and conditions).

Claim Rejections - 35 USC § 103

6. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Reeder in view of Oshima et al. This rejection is set forth in the Office action mailed 13 August 2003 (Paper No. 7).

Response to Arguments

7. Applicant contends that Reeder does not disclose a storage medium including a software program and ID code installed in the user terminal, wherein the user terminal accesses the software program installed therein when a search of a remote database including usage limitations is searched and authorization is provided.

However, Reeder does show a storage medium (150 in Fig. 1) installed in the user terminal (100 in Fig. 1), which stores a software program and an identification code (see page 5,

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lines 10-14). The software program is accessed on the user terminal (see page 5, lines 18-25); a remote database (230 in Fig. 1) having usage limitations is searched (see page 6, line 37, and page 7, lines 1-5); and authorization is provided (see page 7, lines 30-37). Note that the software program is inherently “installed” within the user terminal because it would otherwise be inoperable. The software program is considered “installed” whether it resides on the storage medium (150 in Fig. 1) or in memory (140 in Fig. 1) for execution. Therefore, it is maintained that Reeder anticipates the features recited in independent claims 1 and 5.

Applicant also contends that there are no features in Oshima et al. that could be combined with Reeder and result in the invention as recited in claim 4, which depends from claim 1. However, the features of claim 1 are anticipated by Reeder as presented above, and the additional limitations of claim 4 are disclosed by Oshima et al. as set forth in the prior Office action. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Reeder and Oshima et al. because both references disclose downloading, installing, and/or licensing software with usage fees (see Reeder, page 3, lines 11-20; and Oshima et al., column 4, lines 60-64) and measures to improve security (see Reeder, page 5, lines 33-35; and Oshima et al., column 3, lines 11-15).

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael J. Yigdall whose telephone number is (703) 305-0352. The examiner can normally be reached on Monday through Friday from 8:00am to 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tuan Q. Dam can be reached on (703) 305-4552. The fax phone number for the organization where this application or proceeding is assigned is (703) 746-7239.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

MY

Michael J. Yigdall
Examiner
Art Unit 2122

mjy
January 12, 2004



TUAN DAM
SUPERVISORY PATENT EXAMINER